REMARKS

Claims 49 - 61 were pending in the present application. Upon entry of this amendment, which is respectfully requested for the reasons set forth below, claims 52 – 55, 58 and 59 will be pending. Claims 52, 55 and 58 are independent.

Claims 49 - 51, 56, 57, 60 and 61 have been canceled and claims 52, 55 and 58 have been amended solely to expedite allowance of the present application. Those claims will be pursued in another application. Applicants response to the rejections made in the Office Action are below.

Section 102(b) Rejection of Claims 49 – 57 and 60 - 61

Claims 49 – 57 and 60 – 61 stand rejected as anticipated by either of U.S. Patent No. 5,239,165 to Novak or U.S. Patent No. 4,993,714 to Golightly. Applicants respectfully traverse the Examiner's Section 102 rejection.

Independent claims 52, 55 and 58 each include the step of calculating a change amount. Neither Novak nor Golightly include such a step. Independent claims 52 and 55 also include the step of receiving lottery ticket information that is based on the change amount. Such a step is also absent from both Novak and Golightly. Similarly, independent claim 58 includes the steps of calculating a fractional amount of a full lottery ticket, in which the fractional amount is based on the change amount. Such a step is also absent from both Novak and Golightly.

Since neither reference shows every limitation of any of independent claims 52, 55 and 58, the independent claims and their respective dependent claims are not anticipated by the references cited by the Examiner. Furthermore, as discussed immediately below, independent claims 52, 55 and 58 are not rendered obvious by any of the references cited by the Examiner, alone or in combination.

Section 103(a) Rejection of Claims 58 - 59

Claims 58 – 59 are rejected as being unpatentable over Novak in view of what the Examiner characterizes as well known. Applicants respectfully traverse the Examiner's Section 103(a) rejection.

The Examiner asserts in page 3 of the Office Action that:

> "it is well known to sell fractional lotto shares (rather than a full share). To make the lotto purchasing more popular by making the price of a lotto a customer choice (e.g., by making fractional values available and thereafter enable customers with limited resources to purchase lotto), therefore, it would have been obvious to modify the teachings of Novak by making available fractional lotto."

However, the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination. The teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP § 2143.01.

There is no hint or suggestion in the prior art "to make the lotto purchasing more popular by making the price of a lotto a customer choice". By contrast, the customer has no choice in the prior art since shares of certain high priced tickets are only available in fixed fractions. Accordingly, there is no motivation in any of the references cited by the Examiner, either alone or in combination, to modify or combine the references in any manner that renders obvious the present invention.

As described at page 3 of the present application, some foreign countries allow a lottery player to purchase fractional lottery tickets. However, prior art lottery systems only allow the player to purchase particular fractions of certain high-priced lottery tickets; there is no ability to buy arbitrary fractions of a lottery ticket.

Furthermore, these lottery systems do not allow a customer to purchase a fractional lottery ticket for their change. There is no teaching, hint or suggestion in the prior art cited by the Examiner that addresses the use of change, much less that addresses the disadvantages indicated in the present application and the solution to those disadvantages that the present invention provides. The references lack any teaching or suggestion of selling anything for change, much less lottery tickets. Nothing in the prior art suggests that this would be desirable or useful.

In order to maintain a rejection for obviousness, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. The Examiner has merely stated that the present invention *is desirable* – i.e. that a benefit of the present invention is the increased sale of lottery tickets. However, there is no *suggestion* of this desirability in the prior art or the knowledge generally available to one of ordinary skill in the art.

Applicants agree that he present invention has benefits, such as the increased sale of lottery tickets. However, the mere existence of these benefits cannot constitute a motivation to combine or modify the references. If this were true, any useful invention would be obvious in light of the prior art because the benefits of the invention would be a sufficient motivation to modify the prior art to arrive at the invention. Accordingly, there is no motivation to modify the references in any way that renders obvious the present invention.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number (203) 905-6666 or via electronic mail at alderucci@WalkerDigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a two-month extension of time with which to respond to the Office Action. Please charge $190.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

November 17, 1999
Date

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